

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

UNIU40.005APC

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on _____

Signature _____

Typed or printed name _____

Application Number

10536621

Filed

2005-05-26

First Named Inventor

Masahiko NAKAMORI

Art Unit

1716

Examiner

MaCarthur, Sylvia

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record. 34115
Registration number _____

attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature

Daniel E. Altman

Typed or printed name

(949) 760-0404

Telephone number

September 13, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant	:	Masahiko NAKAMORI et al.
App. No	:	10/536,621
Filed	:	May 26, 2005
For	:	POLISHING PAD AND METHOD OF PRODUCING SEMICONDUCTOR DEVICE
Examiner	:	Sylvia Macarthur
Art Unit	:	1716
Conf. No.	:	9275

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

Enclosed with this Request is a Notice of Appeal.

REASONS FOR REQUEST

Review of the above-identified application is requested for the following reasons:

1. There are Clear Errors in the Examiner's Rejection Under 35 U.S.C. § 103(a)

Claims 1-4, 7, 13, and 15-21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable Ishikawa et al. (U.S. Publication No. 2002/0042243) in view of Shimomura et al. (JP Publication No. 2002-0759933).

Claims 1, 7, 13, and 15-21 have been rejected under 35 U.S.C. § 103(a), as being unpatentable over Takashi et al. (JP 11-07517) in view of Halley (U.S. Patent Number 6,361,647) and Shimomura et al. (JP 2002/075933).

Claims 1, 4, and 7 have been rejected under 35 U.S.C. § 103(a), as being unpatentable over Hasegawa Toru (JP 2002-324770) in view of Halley (U.S. Patent Number 6,361,647) and Shimomura et al. (JP 2002/075933).

The Examiner's rejection contains clear errors in the rejections of the claims. For Example, the Office Action states that the references teach features of the claims which they do not.

a. The cited reference does not teach light transmittance in the light-transmitting region throughout the wave length range of 400 to 700 nm is 50% or more and light transmittance in the light-transmitting region throughout the wave length range of 600 to 700 nm is 80% or more

In rejecting the claims, the Examiner asserts that Ishikawa disclose the above limitations and reads the recited wave length ranges on Figure 12 of Ishikawa. However, as discussed below, Ishikawa does not disclose the claimed wave length ranges in connection with light transmittance and fails to disclose these ranges with sufficient specificity in any connection. With regards to the disclosure of Fig 12 of Ishikawa, the Examiner fails to recognize that Fig 12 of Ishikawa shows the reflective spectrum from the surface of the silicone wafer relative to standard reflective spectrum. In contrast, the claims refer to light transmittance, which is the fraction of incident light that passes through. Thus, the recited light transmittance, unlike the reflective spectrum disclosed by Ishikawa, is not relative value. Therefore the reflective spectrum of Fig 12 of Ishikawa is not equivalent to the light transmittance recited in the claims.

Further, as set forth in MPEP § 2131.03, the claimed subject matter must be disclosed in the reference with "sufficient specificity". The claims recite specific light transmittance thresholds "50% or more" and "80% or more" associating with certain wave length ranges, while Fig 12 of Ishikawa merely shows the reflective spectrum in a range of wavelength from 400 to 800nm. Accordingly, the disclosure of Fig 12 of Ishikawa does not lead one with ordinary skill in the art to the limitations in the claims. In the present case the Examiner has completely failed to recognize this.

Although, Ishikawa teaches that the transmissivity of the window plates be set at 22% or greater (paragraph [0053]), this broad transmissivity range also fails to lead one with ordinary skill in the art to the claimed narrower ranges of “50% or more” and “80% or more”, and also failed to associate with the any particular wave length light transmittance. Thus, Ishikawa’s teaching provides insufficient specificity to be considered a disclosure of Applicant’s claimed features.

The rest of the cited references do not cure the noted deficiencies in Ishikawa. None of these references disclose anything about light transmissivity. The Examiner uses the rest of the references to argue a limitation “a scatter of the thickness the light transmitting region is 100 μ m or less” in Claim 1, however the Examiner fails to realize that the limitation is no longer an alternative as amended on September 21, 2009. In view of these facts, the cited references fail to teach those specific features of the polishing pad of the present invention. Thus, the broad disclosure of Ishikawa does not amount to the claimed ranges, and the Examiner’s rejection should be withdrawn on this basis alone.

Moreover, As shown in Table 1 of the present specification, Example 1 and 2 with the transmittance above 70% in the light-transmitting region throughout the wavelength range of 400 to 700 nm indicates **very good** reproducibility (indicated by ○ ○), Example 3 with transmittance of 51.4% at the wave length of 400 nm, which is slightly above the claimed range, shows **good** reproducibility (indicated by ○), and Comparative example 1, with transmittance of 14.7% at the wavelength range of 400 nm shows poor result. Further, as for an alternative, the claims also recites that the light transmittance throughout the wave length the range of 600 to 700 nm is 80% or more. This alternative also provides unexpected results as shown by the data reported in Table 2 of Applicant’s specification. In particular, Examples 4 and 5 with light transmittance on the recited region above 90% provide good detection of film thickness, while Comparative Example 2 with light transmittance about 75% does not. Such results are completely unexpected in view of the prior art and indicates the criticality of the cited range. These unexpected results and evidence indicating that the claimed ranges are critical can support patentability. See MPEP 2144.05(II) and 2144.05(III)

The Examiner completely failed to take into account the criticality of the claimed range and the evidence of unexpected results based on the light transmittance associating with certain

wave length ranges. It was clear error to have done so. The Examiner's rejection should be withdrawn

CONCLUSION

In view of the foregoing comments, the applicant respectfully submits that the claims are in condition for allowance. The Examiner committed clear error in failing to consider the criticality of the claimed features. Accordingly, reconsideration of the Examiner's rejections is respectfully requested.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: September 13, 2010

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